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ROY A. EKSTRAND 3158 REDHILL AVE., STE 150 COSTA MESA, CA 92626			AUGUSTINE, NICHOLAS	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/696,610
Filing Date: October 28, 2003
Appellant(s): NGUYEN, MITCHELL VAN

Roy A. Ekstrand
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/03/2008 appealing from the Office action
mailed 09/28/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,337,698

KEELY

1-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 3-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Keely et al. (US 6,337,698 B1), herein referred to as Keely.

As for independent claim 1, Keely teaches a pen-based computer interface system comprising: a pen-based computer having a touch sensitive display screen (figure 1), at least one input button, a stylus pen and a memory based processor having a stored operating system therein (column 3, lines 50-60; figure 5); means for causing said processor to operate in a write mode characterized by displaying the movement path of said pen upon said display screen (column 3, lines 61-67); means for causing said processor to operate in a pan mode characterized by the movement of said movement path within said display screen in response to pen contact with and movement upon said display screen (column 10, lines 2-3; scroll shadow is a control, of course those skilled in the art, recognizes controls, GUI elements, buttons are all under the same category of visual cues to the user that perform a function when activated); means for operating said processor in either said write mode or said pan mode; and a single button for controlling said means for operating to allow a user to select

said write mode or said second pan mode (column 3, lines 61-67; column 4, lines 1-22; column 9, lines 63-67; column 10, lines 1-31).

As for dependent claim 3, Keely teaches the interface system set forth in claim 1 wherein said button is a normally open momentary contact switch (column 4, lines 64-67; column 5, lines 1-5; switching from desired function to another desired function).

As for dependent claim 4, Keely teaches the interface system set forth in claim 3 wherein said write mode is selected when said button is open and said pan mode is selected when said button is pressed and closed (column 10, lines 1-31; user selects scroll shadow control, wherein function is closed on that particular function, when user is done control is open to user input).

As for independent claim 5, Keely teaches a *pen-based computer interface system comprising: a pen-based computer having a touch-sensitive display screen and stylus pen together with a processor for writing upon said display screen as said pen touches and is moved upon said display screen to create a write image and for panning said write image in response to pen contact and movement of said pen upon said display screen; a button for user selection between operations of writing or panning; means for causing said processor to implement writing in response to said button being non*

activated; and means for causing said processor to implement panning in response to said button being activated (note the analysis of claim 1 above).

As for dependent claim 6, Keely teaches the interface system set forth in claim 3 wherein said pan mode is selected when said button is open and said write mode is selected when said button is pressed and closed (note the analysis of claim 4).

As for dependent claim 7, Keely teaches the interface system set forth in claim 1 wherein said button is a normally closed momentary contact switch (column4, lines 3-22,64-67; column 5, lines 1-5).

As for independent claim 8, Keely teaches *a pen-based computer interface system comprising: a pen-based computer having a touch-sensitive display screen and stylus pen together with a processor for writing upon said display screen as said stylus pen is moved upon said display screen to form a written image and for panning said written image in response to stylus pen contact and movement said stylus pen upon said display screen; a button for user selection between operations of writing or panning; means for causing said processor to implement writing in response to said button being activated; and means for causing said processor to implement panning in response to*

said button

being non activated (note the analysis of claim 1 above).

As for dependent claim 9, Keely teaches the interface system set forth in claim 7 wherein said write mode is selected when said button is open closed and said pan mode is selected when said button is pressed and opened (note the analysis of claims 1 and 4 above).

As for dependent claim 10, Keely teaches the interface system set forth in claim 7 wherein said pan mode is selected when said button is open closed and said write mode is selected when said button is pressed and opened (note the analysis of claims 1 and 4 above).

(10) Response to Argument

Beginning on page 5 of Appellant's brief (hereinafter Brief), Appellant argues specific issues, which are accordingly addressed below.

A1. As for claims 1, 5 and 8; Appellant argues Keely is not "suited for operation in a handheld personal digital assistant or PDA type device" (page 7 of Brief).

R1. The Examiner notes that the arguments presented by the Appellant are not claimed, thus in response to Appellant's argument that the reference fails to show

certain features of Appellant's invention, it is noted that the features upon which applicant relies (i.e., operation in a handheld personal digital assistant or PDA type device and system that is carried forward with virtually no interruption of the writing process and without the need to move the pen from the writing image) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

A2. As for claims 1, 5 and 8; Appellant characterizes Keely's system as having to stop the writing process in order to activate the panning; wherein the user has to move the stylus from the point of writing to a selected icon within the display screen boarder or reorient or relocate the pen upon the page (page 7 of Brief).

R2. Examiner notes that the current claim language, in particular to claims 1, 5 and 8 that states that a user has to select a button in order to select a panning mode or writing mode, no where in the claim language that it is suggested that the users writing action is not stopped to select the button, it is therefor understood by the Examiner that Keely teaches the immediate claim language, "a single button for controlling said means for operating to allow a user to select said write mode or said pan mode" (col.10, lines 1-12 and 24-32).

A3. As for claims 1, 5 and 8; Appellant argues Keely's system is not "carried forward with virtually no interruption of the writing process and without the need to move the pen from the writing image (page 8 of Brief).

R3. The Examiner does not agree, the Appellant argues continuously on a limitation that features a system able to automatically determine if the system should be in a write mode or in a pan mode based on the users interaction within the system, wherein the users interaction consist of not having to select write mode or pan mode. Yet the last limitation in claim 1 particular mentions the use of a button to activate either a writing mode or a pan mode. The arguments presented by the Appellant are not claimed, thus in response to Appellant's argument that the reference fails to show certain features of Appellant's invention, it is noted that the features upon which applicant relies (i.e., system that is carried forward with virtually no interruption of the writing process and without the need to move the pen from the writing image) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

A4. As for claims 1, 5 and 8; Appellant states that "the Examiner contends that the screen icon mode selection system of Keely is the same as (or presumably equivalent to) the single dedicated mode switch button of the inventive system (page 8 of Brief).

R4. Examiner does not agree, the claim states a single button for performing a function (write or pan). Keely clearly shows at least one "single" button to perform a pan

operation (col.10, lines 24-32). The specification of the immediate application talks about hardware and software but makes no distinction between the two in the current rendering of the claim language. The current claim language is not clear as if the button is physical or not (a part of the user interface), therefore it is evident that Keely meets the claim limitations. Further the Appellant give examples of how the invention is suppose to work on page 10 of Brief, but this characterization is not claimed.

Examiner further points out that each and every limitation claimed is fully taught by Keely, in particular that Keely shows the user able to use a write mode and a pan mode in a pen based computer environment (col.3,lines 50-60); wherein the user can select a single button to enable a pan mode of operation (col. 4, lines 3-22; col.10, lines 1-12 and 24-32).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nicholas Augustine/
Patent Examiner AU 2179
9/24/2008

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